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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Timothy W. Pazdro

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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,510	<b>Applicant(s)</b> PAZDRO, TIMOTHY W.	
	<b>Examiner</b> JAMISUE A. PLUCINSKI	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Thorp (Journal of Disability Policy Studies article).

3. With respect to Claims 21-24: Thorpe discloses a method for conveying a personal message where the message is recorded along side other legal documentation, the lawyer, holding party will deliver the letter/personal message on the occurrence of a triggering event such as death (Page 7, Letters of Intent). Thorpe discloses the letters of intent should be reviewed on a yearly basis, the examiner considers this to be receiving confirmation that the holding party will forward the personal message. (Page 7, Letter of Intent)

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-20 and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tackbary et al. (6,092,054) in view of Lockhardt et al. (US 2002/0103697).

6. With respect to Claims 11 and 25-27: Tackbary discloses the use of a method for assisting an author in conveying a personal message (see abstract) comprising:

- a. Providing a message kit with a first medium configured to receive a personal message (User interface 85, and Figures 4, 5 and 9 with corresponding detailed description),
- b. a second medium configured to receive information associated with an intended recipient (recipient database, 90),
- c. Receiving and storing the message as well as the recipient information (see Figure 4 with corresponding detailed description;
- d. Receiving notification from the fiduciary of the occurrence of the triggering event and send the combination of the first correspondence medium and an envelope to the recipient (see abstract).

7. Tackbary discloses the use of a first directive for notifying a fiduciary of the authors intention to have the first correspondence be sent in an envelope and disclose keeping track of triggering events (see Figure 4 and 6a with corresponding detailed description). However Tackbary fails to disclose the first directive being configured to provide notification to a fiduciary that the first medium and the envelope be sent to the intended recipient in accordance with a preferred receipt data after the occurrence of a triggering event. Lockhardt discloses the use of an electronic messaging system where a printed mailing, such as a correspondence, is created by a user, then sent to a recipient on a preferred date (See Figure 7 with corresponding

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detailed description). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the directive of Tackbary to have the correspondence not be sent until the trigger event or specified date occurs, as disclosed in Lockhardt, in order to increase the efficiency of generating and distributing surface mail and to provide a convenience to the user. (See Lockhardt, Page 1 and 7).

8. With respect to Claims 12 and 28: See Tackbary abstract.

9. With respect to Claims 13, 29 and 30: Tackbary discloses verifying accuracy of information, such as mail mode, whether the card will get to the intended recipient on time (column 9, lines 18-25).

10. With respect to Claims 14 and 31: See Tackbary, Column 5, lines 15-31, Column 6, lines 31-43 and Column 10, lines 6-27.

11. With respect to Claims 15-17 and 32: See Tackbary, See Figures 6A and 8 with corresponding detailed descriptions.

12. With respect to Claim 18: Tackbary discloses the use of a message kit (See abstract, electronic message kit) comprising:

e. A means for recording a personal message (See Figure 9, with corresponding detailed description)

f. A means for forwarding the personal message and handling instructions to a holding party (distribution center), (see Figure 4 and 6a with corresponding detailed description);

g. A means for receiving notification from the fiduciary of the occurrence of the triggering event (Reference numeral 30 with corresponding detailed description).

13. Tackbary discloses a means for instructing a fiduciary of an author's intent for the holding party to send the personal message upon the occurrence of a specified date following the occurrence of a triggering event (See Figure 4 with correspondence detailed description, as well as Database Manager, Figure 2). However fails to disclose the means for instructing a fiduciary that the holding party will send the message upon the occurrence of a specified date of a triggering event. Lockhardt discloses the use of an electronic messaging system where a printed mailing, such as a correspondence, is created by a user, then sent to a recipient on a preferred date (See Figure 7 with corresponding detailed description). It would have been obvious to one have one of ordinary skill in the art at the time the invention was made to modify the directive of Tackbary to have the correspondence not be sent until the trigger event or specified date occurs, as disclosed in Lockhardt, in order to increase the efficiency of generating and distributing surface mail and to provide a convenience to the user. (See Lockhardt, Page 1 and 7).

14. With respect to Claim 19: Tackbary discloses the orders can be written mail (Reference number 50, therefore the personal message can be handwritten.

15. With respect to Claim 20: The claims are directed to a message kit, therefore in essence an apparatus claim, which is held to the structural limitations. The type of event, whether a holiday or an incapacity is merely intended use of the message kit, and therefore does not effect the structure of the claim.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-5, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cangiarella (US 2004/0256281).

18. With respect to Claim 1: Cangiarella discloses the use of a novelty message kit (see abstract), comprising:

h. A first correspondence medium (reference numeral 39), this medium is used to write personal message therefore the examiner considers it to be configured to receive a personal message, a second correspondence medium (mailing label, Paragraph 0015), this receives the recipients address, therefore considered to be configured to receive information associated with the intended recipient (the address), and a first directive (Instructions 42). It should be noted, that the claims are drawn to an apparatus, which are held to the structural limitations. The claims are drawn to essentially a kit with pieces of paper one of a which personal messages can be written on, one of which recipient information can be written on, the other of which instructions can be written on. The limitations of “configured to provide notification to a third party that a holding party in possession of the first correspondence medium completed with the personal message and the envelope will send the combination of the completed first correspondence medium

and the envelope in accordance with a preferred receipt date communicated via the second correspondence medium” as well as “wherein the holding party retains the completed first correspondence medium and the envelope until after the occurrence of an author identified triggering event” and “wherein the third party is not the author” are considered to be intended use of the apparatus and of the instructions. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

19. Cangiarella discloses the use of a shipping box, and fails to disclose the use of an envelope. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to substitute an envelope for a shipping container, since the examiner takes Official Notice of the equivalence of a shipping box and an envelope for their use in the shipping art, and the selection of any of these known equivalent shipping containers would have been within the level of ordinary skill in the art. Cangiarella discloses the use of a box for protective purposes of the container, however padded envelopes are well known to be protective as well. Furthermore, Cangiarella discloses the shipping container to be flat, much like an envelope (Paragraph 0005)

20. With respect to Claim 2: See Paragraph 0016, Cangiarella discloses the use of message paper which the examiner considers to be stationary.

21. With respect to Claims 3 and 4: Cangiarella discloses the use of a correspondence medium, however fails to disclose the medium being greeting cards or post cards. At the time the invention was made, it would have been an obvious matter of design choice to a person of



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ordinary skill in the art to have the correspondence to be either a greeting card or a post card because Applicant has not disclosed that the greeting card or the post card provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either a personal correspondence paper, greeting card, or post card because they all perform the same function of relaying a personal message. Therefore, it would have been an obvious matter of design choice to modify Ciangarella to obtain the invention as specified in claims 3 and 4.

22. With respect to Claims 5, 9 and 10: As discussed above what the correspondences are for, or what is written on them, is considered to be intended use, and the type of information printed on the correspondence medium as well as what the triggering event is, does not structurally change the medium.

23. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciangarella as applied to claim 1 above, and further in view of Kara (6,208,980).

24. With respect to Claims 6 and 7: Kara fails to disclose the use of a confirmation medium with the use of an envelope to send back to the sender for the confirmation medium. Kara discloses a piece of Mail having a confirmation medium attached as well as a return envelope (Column 3, lines 7-14 as well as Figures 19-20 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the kit of Ciangarella to include the return medium and envelope, as disclosed by Kara, due to the fact that the combination of familiar elements according to known methods is

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likely to be obvious when it does no more than yield predictable results. See KSR [127 S Ct. at 1739]

25. With respect to claim 8: Due to the fact that Claim 8 is dependent on Claim 1, the examiner considers the confirmation medium of Kara, to also be a form of a second directive, due to the fact that it directs the recipient to send back return correspondence.

### ***Response to Arguments***

26. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. It should be pointed out that the claims do not preclude that the correspondence mediums can be in electronic form, and being held, can mean being saved within a database. .

27. It should also be noted that with respect to Claim 21: The prior art states that the letter of intent is written by a parent or guardian, it does not disclose it is written by the lawyer.

### ***Conclusion***

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629